Remarks

Claims 1 and 4-17 remain in the above captioned application. Claims 1 and 4-17 have been rejected as unpatentable under 35 U.S.C. §103 (a), over United States Patent No. 6,192,064, entitled NARROW BAND LASER WITH FINE WAVELENGTH CONTROL, issued to Algots, et al. on February 20, 2001, based upon an application Ser. No. 09/470,724, filed on December 22, 1999 ("Algots") in view of Japanese laid open application Ser. No. 03-108,454, filed on April 12, 1991, published on November 5, 1992, Pub. No. 04-314374, with inventors Osamu, et al., entitled NARROW BAND LASER DEVICE ("Osamu '374).

Applicants submit that the Examiner's rejection of the claims is not proper both because Algots is not a reference under 35 U.S.C. §103 (c) and because the art as a whole based upon the record before the Examiner teaches away from the approach disclosed in Osamu '374. Algots is commonly owned and the above captioned application was filed on November 17, 2000, before the issue date of Algots, so that Algots is a §102 (e) type reference for purposes of §103. In addition, however, even were another reference substituted for Algots, which is a proper reference, the Examiner's reliance on Osamu '374 is also improper.

The Examiner must consider the prior art as a whole, including portions, which would lead away from the claimed invention.[1] This principle applies when references specifically disagree with each other. In such a case the Examiner must weigh the suggestive power of each reference, which is simply also, for a *prima facie* case of obviousness, part of the consideration of whether or not there is an adequate suggestion in the art to combine references as the Examiner has proposed.[2] In *Young, supra*, the earlier reference taught a feature of the claimed invention and a subsequent reference taught that the feature disclosed in the earlier reference would not work. The court held that this contrary teaching must be taken into account but that the later opinion was not valid, because it was not based on an accurate examination of the earlier disclosed feature.

[1] M.P.E.P. §2141.03, *citing, W.L. Gore & associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 203 (Fed. Cir. 1983, *cert. denied*, 469, U.S. 851 (1984).
[2] M.P.E.P. §2143.01, *citing, In re Young*, 927 F. 2d 588, 18 U.S.P.Q. 1089 (Fed. Cir. 1991).

That deficiency in evaluation of the earlier criticized reference by another party is not the case here. Here the very same inventors of the subject matter of an earlier published patent application abandoned that patent application and filed for and obtained a patent on a technique totally contrary to that proposed in the published application. Attached as Exhibit A to this amendment is a copy of patent abstract for Japanese Patent No. 2696285; issued on Patent Application Number 03-352812 filed on December 16, 1991, resulting in Pub. No. 05-167172 (July 2, 1993) ("Osamu '172") and as Exhibit B, a copy the patent abstract for of Japanese laid open application (Publication) No. 04-314374, published on November 5, 1992, and based upon an application 03-108454 filed on April 12, 1991 ("Osamu '374"). So, the later filed contrary disclosure (Osamu '172) issued as a patent and the earlier filed application (Osamu '374"), filed in 1991, has not issued as a patent.

Applicants submit that these facts place in the record information, which the Examiner must use to weigh the suggestive power of each of the contrary references. The Examiner is, of course, right that a reference "is good for everything that it teaches," however this can be overridden by another conflicting reference, as the cases noted above hold. Applicants also submit that the facts of record regarding Osamu '172 following Osamu '374 in application date and Osamu '172 being completely contrary to Osamu '374, is sufficient evidence that the very same inventors of Osamu '374 decided that Osamu '374 was not the way to approach the problem later addressed in Osamu '172 by the very same inventors in a completely contrary manner to that suggested in Osamu '374.

Applicants submit that this evidence is true regardless of Osamu '172 not specifically saying the technique of Osamu '374 "is to be avoided." This is not *Young, supra*, where a stranger criticized the earlier reference. This is the same inventive entity abandoning one approach for a totally contrary approach. Applicants are not speculating that the inventors abandoned Osamu '374. The facts in the record indicate that Osamu '374 was first filed, the totally contrary Osamu '172 was later filed by about five months, the later filed Osamu '172 issued as a patent in 1997, over six years ago, and Osamu '374 has not issued as a patent.

That constitutes evidence of the second reference teaching away from the first and it is now the requirement for the Examiner to put in the record some evidence as to why this evidence is not sufficient to show the later reference teaches away from the first, and mitigates against any suggestion to combine the earlier reference to reach the claimed invention as the Examiner has done. *In re Lee*, 277 F.3d 1338, 1345, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002) ("'deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is "basic knowledge" or "common sense."' The Board's findings must extend to all material facts and must be documented on the record, lest the 'haze of so-called expertise' acquire insulation from accountability."); *In re Thrift*, 298 F.3d 1357, 1364, 63 U.S.P.Q.2d 2002 (Fed. Cir. 2002) ("the Board's reliance on 'common knowledge and common sense' did not fulfill the agency's obligation to cite references to support its conclusions ... the Board must document its reasoning on the record to allow accountability. This documentation also allows effective judicial review." *citing*, *Lee* at 1344-45)

For the above stated reasons applicants submit that there is no suggestion in the art to combine Algots with Osamu '374 as the Examiner has done and, indeed, the art as a whole teaches away from doing so, because Osamu '172 is contrary to and, under the facts of record, is what the very inventors of Osamu '374 teach those skilled in theart to do. That teaching of these very same inventors is contrary to and teaches away from Osamu '374. The Examiner has no reason, in weighing the suggestive power of each of the references Osamu '172 and Osamu '374, to conclude that, under the facts of record, Osamu '172 does not teach away from Osamu '374. The Examiner has no reason on the record to determine that the "suggestive power" of Osamu '172 is not strongly on the side of suggesting to one skilled in the art that the subsequent approach of the inventors in Osamu '172 teaches that the prior effort was viewed by the very same inventors as a failed effort.

The Examiner's combination of the Algots and Osamu '374 references is not proper and for this reason there is no *prima facie* here for obviousness. For the same reason the Examiner's further addition of Osamu '172 as to claims 9-12 and 17-17 is also improper, because the combination of Algots and Osamu '374 in the first instance is not

proper. The Examiner is respectfully requested to withdraw the rejection of claims 1 and 4-19 and allow claims 1 and 4-19.

Applicants' authorize the Commissioner to charge our Deposit Account No. 03-4060 in the amount of $110.00 for the one-month extension fee. Applicants' do not believe any other fees are due in connection with this submission however if any fees are due, the Commissioner is authorized to charge our Deposit Account No. 03-4060 the appropriate amount.

Respectfully submitted,

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